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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,825	03/13/2001	Kimihiro Yamasaki	55698(904)	2050
21874 7590 08/04/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
SWEARINGEN, JEFFREY R				
ART UNIT		PAPER NUMBER		
2445				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/804,825

Applicant(s)

YAMASAKI ET AL.

Examiner

Jeffrey R. Swearingen

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/9/09 have been fully considered but they are not persuasive.
2. Applicant argued that Carter failed to teach *on-going selection of information being performed by the information selecting portion provided in the device*. However, Motoyama taught the on-going selection of information being performed by the information selecting portion provided in the device. Motoyama selects on an an-going basis the summary information to be transmitted regarding the status of the devices. Motoyama, column 14, lines 2-16. Motoyama determined if the information was urgent or non-urgent. Motoyama, column 14, lines 25-60.
3. Applicant argued there was no motivation to combine Motoyama with Carter. Motoyama transmitted attachments with email. It is well known in the art that large attachments can cause problems in transmission. Carter states this well known problem in column 3, and directly addresses a solution for it.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-10, and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al. (6,631,247) in view of Carter (US 6,859,213).

6. In regard to claim 1, Motoyama disclosed a management system which set status messages from a device to a server by use of electronic mail. Motoyama, column 14, lines 1-53. Motoyama disclosed data was in a predetermined format such as Excel or HTML. Motoyama, column 14, lines 16-20. Attachments were used in the email messages. Motoyama, column 17, lines 58-63. Motoyama disclosed using a command to collect device information in column 18, lines 1-62. Attachments were used in email in Motoyama, column 17, lines 58-63.
7. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Carter likewise disclosed an analogous email attachment system. Carter, column 3, lines 44-59. Carter did disclose the ability to choose whether the data to be transmitted was to be attached to the email or sent within the email. Carter, column 3, lines 51-59; column 7, lines 57-65. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Carter email attachment system with Motoyama in order to allow large files to be transmitted in case an email system has a limitation on the size of the body of an email. Carter, column 3, lines 10-13.
8. In regard to claim 4, Motoyama in view of Carter disclosed:
said transmission processing section is set so as to convert use information indicating the state of use of said management target device into attached data.
Motoyama, column 14, lines 1-62, where data regarding the status of a device was sent

via email to a managing device. The use of the Excel format in lines 16-20 taught the use of attachments, as also shown in column 17, lines 58-63.

9. In regard to claim 5, Motoyama in view of Carter disclosed:

said transmission processing section is set so as to convert use information indicating the state of use of said management target device into attached data. Motoyama, column 14, lines 1-62, where data regarding the status of a device was sent via email to a managing device. The use of the Excel format in lines 16-20 taught the use of attachments, as also shown in column 17, lines 58-63.

10. In regard to claim 5, Motoyama in view of Carter further disclosed

said transmission processing section is set so as to transmit device information regarding a plurality of management target devices located in a predetermined area by a same electric mail. See Motoyama, column 14, lines 21-40, where multiple devices can transmit status information to a managing server.

11. In regard to claim 6 Motoyama in view of Carter further disclosed

said transmission processing section is set so as to send the electric mail transmitted to the manager, also to another destination according to a request by a user. Motoyama disclosed that multiple persons such as home users were recipients of the status information messages. Column 14, lines 54-62.

12. In regard to claim 7, Motoyama in view of Carter further disclosed

said transmission processing section includes an encoding section for encoding attached data, and is set so as to have the encoded attached data in an electric mail. In column 14, Motoyama disclosed the encoding of data into a format such as Excel or HTML. In column 17, lines 58-63, Motoyama disclosed sending email with attachments present. The relationship of these attachments to the Excel or HTML formats being sent to a user in column 14 is inherent to Motoyama.

13. In regard to claim 8, Motoyama in view of Carter disclosed

an information communication device notifying a managing device of device information collected regarding a management target device by electric mail, said information communication device including an information selecting station for selecting which of the collected device information is to be converted into attached data; and a transmission processing section that converts the device information into attached data or mail data, in accordance with the selection performed by the information selecting section, and transmits an electric mail containing both the attached data and the mail data to said managing device; a management target device that causes said information communication device to transmit an electric mail containing device information; and a managing device that performs remote management of said management target device, based on the device information contained in the electric mail transmitted from said information communication device. Motoyama disclosed the transmission of status information for a device using email and attachments

in column 14, lines 1-53, and column 17, lines 58-63. Motoyama disclosed managing the device remotely via email commands in column 18, lines 39-62.

The remaining limitations of claim 8 are treated in the rejection of claim 1.

14. Claim 9 is substantially the same as claim 1.

15. Claim 10 is substantially the same as claim 1.

16. In regard to claim 33, Motoyama further disclosed

said attached data is produced by a dedicated program, whereby said attached data is readable only by said dedicated program. Motoyama allowed a user to transmit data in a predetermined format. Column 14, lines 16-20. The transmission of data in a predetermined format such as Excel was readable only by a "dedicated program" such as Excel.

17. In regard to claims 36-39, Motoyama failed to explicitly disclose selecting whether data was to be an email attachment or within the email at the target device. Motoyama disclosed a management system which set status messages from a device to a server by use of electronic mail. Motoyama, column 14, lines 1-53. Motoyama disclosed data was in a predetermined format such as Excel or HTML. Motoyama, column 14, lines 16-20. Attachments were used in the email messages. Motoyama, column 17, lines 58-63. Motoyama disclosed using a command to collect device information in column 18, lines 1-62. Attachments were used in email in Motoyama, column 17, lines 58-63.

18. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency

was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Carter likewise disclosed an analogous email attachment system. Carter, column 3, lines 44-59. Carter did disclose the ability to choose whether the data to be transmitted was to be attached to the email or sent within the email. Carter, column 3, lines 51-59; column 7, lines 57-65. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Carter email attachment system with Motoyama in order to allow large files to be transmitted in case an email system has a limitation on the size of the body of an email. Carter, column 3, lines 10-13.

19. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Carter in view of Wong et al. (U.S. Patent No. 6,654,746).

20. In regard to claim 34, Motoyama in view of Carter failed to disclose the compression of an email attachment. However, Wong in the field of art of email transmission disclosed the ability to transmit a compressed email attachment within a message in column 10, lines 13-27. Therefore it would have been obvious to one of ordinary skill in the art to compress the attachments in Motoyama in view of Carter as shown by example in Wong in order to reduce internet traffic, bandwidth usage, and packet transfer latency during transmission.

21. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Carter in view of Vaudreuil (US 5,740,230).

In regard to claim 35, Motoyama in view of Carter is applied as in claim 1. Motoyama in view of Carter failed to disclose filtering of "confidential" data from data and attaching it separate from other data in an email message. However,

privacy filters and mail filters were well known to one of ordinary skill in the art, and were commonly used in defense and national security applications to prevent information from being sent in the open. Further, at the time of the invention public key cryptography was commonly used in email and involved transmitting a private key along with mail data to allow a user to decrypt the message. Vaudreuil demonstrates an example of this in column 28, line 63 – column 29, line 7. Seeing that many privacy applications were in existence at the time of the invention to allow for sending confidential data in the private along with mail data in the public, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such technology into an email management program to prevent proprietary device information and password information from being intercepted by cyber criminals during the transmission of said email messages.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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